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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,551	12/12/2001	Jean-Pierre Pascault	CV-31583	2290

22202 7590 09/24/2003

WHYTE HIRSCHBOECK DUDEK S C  
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EXAMINER

TESKIN, FRED M

ART UNIT PAPER NUMBER

1713

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/937,551

Applicant(s)  
Pascault, et al.

Examiner  
Fred Teskin

Art Unit  
1713



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit 1713

1. The preliminary amendment of 12 December 2001 has been entered in full. Accordingly, claims 1-28 are currently pending and under examination.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 371, which papers have been placed of record in the file.

3. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (and claims dependent thereon) is indefinite in the recitation "Cardura E10 (meth)acrylate". It is not clear whether "Cardura E10," which appears to be a trademark or tradename, is intended to further limit "(meth)acrylate," or is mere surplusage to the claim. In the latter case, the term should be deleted as superfluous. In the former case, the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated therewith. Clarification and appropriate correction are required.

Art Unit 1713

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over GB 2178048 A ("Ricoh").

Ricoh describes polymer particles having a size between 10 and 300 nm, obtained by radical-mediated dispersion polymerization in a non-aqueous medium of a composition including species of applicants' monomers A, B and C as claimed. See page 1, lines 5-6

Art Unit 1713

and 61+; page 2, lines 9-14 and 56-57; page 4, line 51; and page 7, Examples 2-4.

It is noted that in said examples, monomers B-4, B-6 and B-9 each contain two free radically polymerizable ethylenically unsaturated groups and, moreover, they are not species of the "allylic (meth)acrylate" excluded from the scope of applicants' "second component B" by the negative limitation recited in claim 1. That is to say, said monomers each contain an ester moiety which is not an allylic group (i.e.,  $-C_3H_5$ , as in Example 1 of Ricoh) but rather a  $C_5$ ,  $C_9$ , or  $C_{16}$  hydrocarbyl group with terminal ethylenic unsaturation. As such, these B monomers are found to qualify as the "second component B" of claim 1.

Further, by stating that monomer B does not cause an excessively rapid cross-linking reaction (page 1, line 63) and that it can be a cross-linking component (page 2, line 5), Ricoh does not preclude the possibility of partial cross-linking occurring. Therefore, it is reasonable to conclude that Ricoh also discloses cross-linked polymer particles.

Accordingly, the crosslinked microparticles defined by the rejected claims reasonably appear to be the same as, or patentably indistinguishable from, the polymer particles disclosed by Ricoh.


Art Unit 1713

7. Claims 20-27 would be allowable if amended or rewritten to overcome the rejection under 35 U.S.C. § 112 set forth in this Office action. Examiner has not, as of the date of this Office action, located or identified any prior art document(s) that can be used to render the composition defined by said claims anticipated or obvious to one of ordinary skill in the relevant art.

8. Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (non-after finals) and (703) 872-9311 (after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
FRED TESKIN  
PRIMARY EXAMINER

FMTeskin/09-15-03